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10/049,586	02/12/2002	Perry J. Blackshear	14014.0349U2	9700

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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,586

Applicant(s)

BLACKSHEAR ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-63 and 70-72 is/are pending in the application.
- 4a) Of the above claim(s) 39-52, 62, 63 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-61, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 28 March 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

RD

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 39-52, 62, and 63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 17 March 2004.
2. Newly submitted claim 70 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 70 is drawn to a different method that is comprised of different method steps and which results in different end product. In particular, claim 53 is drawn to a "method of identifying a compound that modulates the binding activity of a tristetraproline (TTP) or a TTP-like peptide to an AU-rich element," while claim 70 is drawn to a "method of identifying a compound that modulates the binding of a tandem zinc finger (TZF) polypeptide to an AU-rich element."
3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 70 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.
4. This application contains claims 39-52, 62, and 63 drawn to an invention nonelected with traverse in response received 17 March 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Specification*

5. The specification is objected to as documents have been improperly incorporated by reference. In particular, the specification states:

Throughout this application, various publications, patents, and/or patent applications are referenced in order to more fully describe the state of the art to which this invention pertains. The disclosures of these publications, patents, and/or patent applications are herein incorporated by reference in their entireties to the same extent as if each independent publication, patent, and/or patent application was specifically and individually indicated to be incorporated by reference.

Such omnibus language fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited documents.

6. Attention is also directed to MPEP 608.01(p)I, which, in pertinent part, is reproduced below:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. (Emphasis added)

7. As set forth In *Ex parte Raible*, 8 USPQ2d 1707, (BPAI, 1998)

The examiner is of the opinion that the general incorporation by reference of the Bentley disclosure in appellant's specification is insufficient to support the specific disputed limitations of the present claims in the manner required by section 112 of the statute. We agree

\* \* \*

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We believe that the doctrine of incorporation by reference is of no avail to appellant in this regard since there is no specific indication in the instant specification of the particular features disclosed by Bentley which correspond to those intended for use in the here-claimed device; nor does the specification identify the specific portions of the patent which appellant may have intended to rely upon to supplement his disclosure. The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found. *In re de Seversky* , 474 F.2d 671, 177 USPQ 144 , (CCPA 1973).

8. Accordingly, the cited documents are not considered to have been properly incorporated by reference and as such, have not been considered with any effect towards their fulfilling, either in part or in whole, the enablement, written description, or best mode requirements of 35 USC 112, first paragraph.

*Response to argument*

9. Applicant is urged to consider removing language, which states that the various documents have been incorporated by reference.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 53-61, 71, and 72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

A review of the specification fails to identify where applicant has provided an adequate written description of the now claimed method. While the specification has been found to comprise several examples, no example, or any other supporting disclosure, has been found to describe the claimed method in such full, clear, and concise language so as to reasonably suggest that applicant was in possession of the invention at the time of filing. While one is not required to provide examples of each and every embodiment encompassed by the claims, the specification still must provide such a full, clear, concise, and exact description of the invention so as to reasonably suggest that applicant was in possession of the invention. As noted above, such disclosure is not found in the instant application wherein the method is drawn to identification of compounds that modulate the binding of tristetraproline or a TTP-like polypeptide to an AU-rich element. In addition to the specification not teaching the claimed method in language sufficient to satisfy the written description requirement, the specification does not teach where any compound has been discovered/identified as a result of practicing the claimed method.

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For the above reasons, and in the absence of convincing evidence to the contrary, claims 53-61, 71, and 72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Response to argument

12. At page 23, bridging to page 24 of the response received 28 March 2005, hereinafter the response, applicant's representative asserts that the issues of satisfaction of the written description requirement of 35 USC 112, first paragraph, can be distinguished over the decision in *Rochester*. In support of this position attention is directed to page 30 of the specification, which was reproduced, starting at line 8.

The above argument has been fully considered and has not been found persuasive. The cited and reproduced portion of the specification teaches that any of a variety of "assays could" be practiced, or what "would probably be the most convenient," or that certain reagents "could probably be shortened," etc. (emphasis added). Such forward-looking statements do not constitute the full, clear, concise, and exact written description required under 35 USC 112, first paragraph. The forward-looking suggestions do not reasonably suggest that applicant was in possession of the invention at the time of filing. Rather, it appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

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13. At page 25 of the response applicant's representative asserts that the specification does provide examples, directing attention to Example 2 (page 55, lines 7 to 20).

14. The above argument has been fully considered and has not been found persuasive as the claimed method is not directed to simply having human TTP bind to the ARE of TNF $\alpha$ -3'-UTR. Rather, the claimed method is directed to a method, which identifies compounds that modulate such activity. Neither a review of the specification nor the response identify where any such compound has been identified as a direct result of practicing the claimed method. Therefore, and in the absence of convincing evidence to the contrary, the rejection is maintained.

15. Claims 53-61, 71, and 72 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well-established utility.

16. It matters not whether the claim is drawn to a product or process; the claim must be drawn to an invention that satisfies the utility requirements as set forth under 35 USC 101 and as further developed in the Utility Guidelines. In support of this position, attention is directed to *Brenner, Comr. Pats. v. Manson*, 148 USPQ 689 (US Sup Ct 1966):

Whatever weight is attached to the value of encouraging disclosure and of inhibiting secrecy, we believe a more compelling consideration is that a process patent in the chemical field, which has not been developed and pointed to the degree of specific utility, creates a monopoly of knowledge which should be granted only if clearly commanded by the statute. Until the process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area. Such a patent may confer power to block off whole areas of scientific development, without compensating benefit to the public. The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. Unless and until a process is refined and



developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.

\* \* \*

We find absolutely no warrant for the proposition that although Congress intended that no patent be granted on a chemical compound whose sole "utility" consists of its potential role as an object of use-testing, a different set of rules was meant to apply to the process which yielded the unpatentable product. 24 That proposition seems to us little more than an attempt to evade the impact of the rules which concededly govern patentability of the product itself.

This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something "useful," or that we are blind to the prospect that what now seems without "use" may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.

17. At page 18, line 21, bridging to page 19, line 3, applicant asserts "TTP deficiency has similar effect on the stability of another mRNA containing a class II ARE, i.e., the mRNA encoding GM-CSF... The present studies allow for the development of new therapeutic approaches for stimulating GM-CSF production, for example, in a patient or subject, by increasing the stability of its mRNA." Page 19, lines 18-21, state "[t]he patient can be human or non-human primate, or any animal that experiences granulocytopenia (e.g., a cat, a dog, a horse, a bird, or a rodent) as part of a pathological condition or exposure to a granulocyte-depleting amount of a toxic substance (e.g., a chemotherapeutic agent). Additionally, populations of cells in vitro can be enriched for granulocytes according to the present method. These cells may be from cell culture or they may be primary cells ex vivo. These populations of cells can be used as research tools to study GM-CSF or they can be returned to the subject."

18. In order for the claimed method to have utility, the method must give rise to a product that in turn has utility, or has been shown to give rise to a product or method that in turn has

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utility. In the present case, the specification does not teach where any compound has been identified by the claimed method, much less that the product so identified has in fact been found to satisfy the utility requirements, either directly or indirectly. Therefore, and in the absence of convincing evidence to the contrary, claims 53-61, 71, and 72 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well-established utility.

19. Claims 53-61, 71, and 72 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

### ***Conclusion***

20. Rejections and/or objections found in the prior Office action and not repeated hereinabove have been withdrawn.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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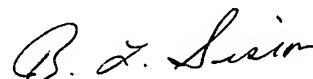
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751.

The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson  
Primary Examiner  
Art Unit 1634

BLS  
20 April 2005